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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,264	07/24/2001	Jonathan Zittrain	111267.120	4128
23483	7590	07/29/2004	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE STREET BOSTON, MA 02109			MULLEN, THOMAS J	
			ART UNIT	PAPER NUMBER
			2632	
DATE MAILED: 07/29/2004				

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/912,264

Applicant(s)

ZITTRAIN ET AL.

Examiner

Thomas J. Mullen, Jr.

Art Unit

2632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,7,12,13,17-19,22,23 and 25-35 is/are rejected.
- 7) ☒ Claim(s) 2,3,5,6,8-11,14-16,20,21 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: ____.  |

1. The disclosure is objected to because of the following informalities: p. 1, line 24, "others devices" should be --other devices--; p. 5, line 2, "provide" should be --providing--; p. 6, line 13, it appears that "changes" should be --states--; and p. 9, line 21, it appears that "years" should be --meters--.

Appropriate correction is required.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4, 22-23 and 25-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4, lines 1-2, "the change in the state of the second device stays in the changed state" is vaguely worded; i.e., it appears that "the change in the state of" is superfluous and the claim would be clearer by simply deleting this phrase.

Claims 22-23, "the receiver" lacks antecedent basis (note the dependency of these claims).

Claim 25 is a "method" claim according to the preamble, but does not clearly recite any method "steps"; i.e., it appears that the limitations on lines 2-6 should begin with terms such as "sensing", "transmitting", "receiving" and "changing" rather than with "a first device", "the first device", "a second device" and "the second device", respectively (references to the first and second "devices" can and should still be incorporated into the method steps).

At the end of claim 25, "the change in first device" lacks clear antecedent basis; i.e., line 2 of the claim recites in part that the first device senses "a change in a physical state" without specifying that such physical state is a "state" of the first device itself.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4, 7, 12, 13, 17, 25 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Narcisse (US 4675656).

Note in Narcisse, "first device" 20 comprising a "sensor" (24,26,30) and a transmitter 28; and "second device" 10 comprising a receiver 16 and a "mechanism" 18 for changing the state of the second device. In particular, second device 10 normally transmits a signal (F1 in Fig. 1) to the first device 20, such that when first device 20 goes beyond a predetermined distance from the second device 10, a "change in physical state" is sensed at the first device (note e.g. receiver 24 and "threshold" 26), which change is an alarm activation state and is signified by an alarm output 30 (col. 3, lines 11-15); in response to the alarm activation state at the first device 20, a signal (F2 in Fig. 1) is transmitted by the first device 20 to the second device 10, whereby the "mechanism" (i.e., internal circuitry) of the second device 10 changes the state thereof to an alarm activation state and activates a corresponding alarm output 18 (col. 2, lines 38-46). Narcisse teaches that the alarm outputs 18 and 30 are both "audible signal(s) modulated on the second frequency (F2)", and thus the "changed states" of the first and second devices (20 and 10) are "substantially similar" to each other.

Regarding claim 4, in Narcisse the "alarm activation" states are maintained until the first device 20 returns to less than the predetermined distance from the second device 10.

Regarding claims 7 and 32, in Narcisse the transmitter 28 of first device 20 transmits "directly" to second device 10.

Regarding claim 12, Narcisse teaches providing "identification codes" to the devices, whereby signals F1 and F2 are encoded/decoded by each device so that "other devices of a similar or different type" do not receive signals intended for transmission between the first (20) and second (10) devices.

Regarding claim 13, Narcisse teaches that first device 20 may be "strapped to the wrist" of the person carrying the device, i.e. that the first device may be in the form of a "bracelet".

Regarding claim 17, in Narcisse the second device 10 does not have a "sensor and transmitter" as does the first device 20 (i.e., the second device 10 just has a transmitter 12 and

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does not have a "threshold"-type element), whereby the change in physical state is transmitted only one way, i.e. from the first device 20 to the second device 10.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 18-19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cataldo (US 4121160) in view of either LaWhite et al (US 4491970) or Levinson et al (US 4611198).

Note in Cataldo, communications system comprising a "wearable" first device (case 5, necklace 8); sensor (12,12',13,13') for sensing a "squeezed contraction" to the first device (see the Abstract and col. 2, lines 27-45); and transmitter (1,6) for transmitting a signal indicative of the "contraction", to e.g. police or emergency medical personnel (col. 1, lines 5-10). Thus, Cataldo teaches all the subject matter of claim 18 except for the wearable first device being a "bracelet". However, at the time of the invention it was well known in the art of wireless emergency communications that portable devices carried by individuals (to initiate a wireless emergency communication as needed) may be sufficiently miniaturized so as to take on a wide variety of physical forms, e.g. necklaces, bracelets, belt-mounted pagers, etc, so as to not be overly cumbersome to the user; for example LaWhite et al and Levinson et al are from the same art as Cataldo, and teach that a portable user-carried transmitting device may be, e.g., either a necklace-type or a bracelet-type (see e.g. lines 2-3 of the Abstract in LaWhite et al, and col. 1, line 32 in Levinson et al). Therefore, in view of either LaWhite et al or Levinson et al, one skilled in the art would have recognized that the necklace-type communications device of Cataldo can be readily implemented as a bracelet-type device, and it would have been obvious to do so depending on the needs and/or tastes of a particular user.

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Regarding claim 19, Cataldo implicitly teaches providing the police or emergency medical personnel with a "second device" for receiving the signal and providing an "indication" of the contraction ("alarm or telephone dialing service"--col. 1, line 10).

Regarding claim 23, it appears to be inherent in Cataldo that the transmitter (1,6) transmits to the receiver (mentioned above with respect to claim 19) "directly".

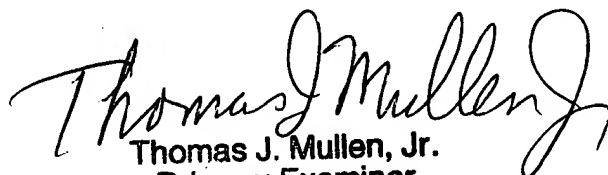
8. Claims 2,3,5,6,8-11,14-16,20-22,24,26-31 and 33-35 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mullen, Jr. whose telephone number is 703-305-4382. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu, can be reached on (703) 308-6730. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

TJM

  
Thomas J. Mullen, Jr.  
Primary Examiner  
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